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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358

29053 7590 12/27/2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/820,554	Applicant(s) TANNENBAUM, DAVID H.	
	Examiner Dominic D. Saltarelli	Art Unit 2611	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-15, 21-31 and 47-59.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: The amendment to claim 48, and additionally the newly added claims 60-67 require further consideration.


Continuation of 11. does NOT place the application in condition for allowance because:

1) Regarding applicant's remarks regarding the applicability of the references to the instant application under 35 USC 102(e) on page 9, stating that the effective date of the 1999 amendment to 35 USC 102(e) did not go into effect until after the filing of the instant application, MPEP 2136 states "Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. Thus, the filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supersede all previous versions of 35 U.S.C. 102(e) and 374".

2) Regarding applicant's remarks regarding claim 50 on page 12, applicant argues that McKissick does not teach adjusting transmission time according to the time zone of each user. In response, the claim does not require that the actual transmission time from the source is at all altered, because the term transmission time, as used in the claim, is operatively defined within the claim as being established by the recording instructions sent to the user, and does not refer to the actual time of transmission of any content. Claim 50, lines 7-10 state "sending program recording instructions from a program transmission source to equipment at said user's premises, said recording instructions operative for establishing a start and stop transmission time for recording said program when said program is transmitted to said user" McKissick teaches this claim limitation based upon the context of the claim language's use of the term "transmission time", because it is defined as the start and stop times identified within program recording instructions, which McKissick teaches are set to be the correct times for a particular user, meaning that any factors that would present a time difference between transmission and reception by a user, such as a change in time zone, is adjusted for so that the user's recorder records the program at the correct time.

3) Regarding applicant's remarks regarding claim 4 on page 13, applicant argues that McKissick does not teach providing user's recorded information is made available to the movie provider. In response, examiner must note that the transmission source is a content provider, based on the simple fact that it provides content to the users. The term "content provider" is not so limited as to refer only to a third party source separate from a transmission source.

4) Regarding applicant's remarks regarding claim 6 on pages 13-14, applicant argues that McKissick does not teach "interactive between the content provider and said user" as claimed, stating that McKissick is a passive system and "interacting" requires active participation. In response, examiner must note that any measurable occurrence between a content provider and a user is "interaction", and even the act of providing a movie from a content provider to a user is an "interaction" between the content provider and the user. However, even with this fact noted, McKissick does teach actively ordering content from a content provider, as shown in the previous office action, which cited McKissick, page 18, lines 30-33.

  
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